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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/552,847	08/09/2006	Jack Taunton	018062-006210US	2596
20350 7590 01/16/2009 TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834				
EXAMINER KIFLE, BRUCK				
ART UNIT		PAPER NUMBER		
1624				
MAIL DATE		DELIVERY MODE		
01/16/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/552,847

Applicant(s)

TAUNTON ET AL.

Examiner

Bruck Kifle

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3, 5-8, 10-47, 50-54 and 57-62 is/are pending in the application.
- 4a) Of the above claim(s) 26-46, 50, 57 and 59 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3, 5-8, 10-25, 47, 51-54, 58 and 60-62 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Applicant's amendments and remarks filed 10/15/2008 have been received and reviewed. Claims 3, 5-8, 10-47, 50-54 and 57-62 are now pending in this application. Claim 63 is now not present. Inclusion of the claim with the proper status identifier is required in response to this office action so that the claims are according to the rules.

Claims 26-46, 50 and 57 are withdrawn from consideration as being drawn to non-elected subject matter. In addition, claim 59, drawn to an "array" was inadvertently not withdrawn in the previous office action but should have been withdrawn. Thus, claims 3, 5-8, 10-25, 47, 51-54, 58 and 60-62 are under consideration. Note, compounds, corresponding compositions, a method of use and a process of making that are of the same scope are considered to form a single inventive concept under PCT Rule 13.1, 37 CFR 1.475(d).

Claim Rejections - 35 USC § 112

Claims 3, 5-8, 10-25, 47, 51-54, 58 and 60-62 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

i) In claim 3, the nature of "E" is unclear. The term "comprises" is open ended. A carbonyl group requires an additional radical because it is the divalent group -C(O)-. The nature of the electron withdrawing group which is conjugated to the olefin is unclear. It appears that this electron withdrawing group requires the presence of a double bond to be conjugated with the olefin. Also, it is unclear what this looks like.

ii) The term "substituted" without saying which substituents are intended is indefinite. One skilled in the art cannot say which substituents are permitted and which ones are not. Applicants

point to paragraph 43 of the specification. Here, however, mere examples have been listed. If these are the intended substituents, these should be listed in the claims.

iii) Regarding the term “heterocyclic,” Applicants point to paragraph 42 of the specification.

However, the definition does not say how many atoms make up the ring, which atoms (beyond the “typically oxygen, nitrogen, sulfur and or phosphorous”), how many heteroatoms are present and how many ring(s) are intended.

iv) In the definition of R^2 , “carboxylic ester” and “carboxamide” are listed as substituents.

However, these are compounds and do not have points of attachment. A clarification is required. Similarly, in R^5 “alkyl- or aryl-substituted ether thioether, or amine” is present. These, again are compounds.

v) Claim 62 depends from itself. Appropriate correction is required.

Applicants are again queried as to the excluded compound. Is this compound excluded to avoid a prior art rejection? If so, Applicants are urgently requested to point to this compound in the prior art because the disclosure of this compound is material to the examination of this case. The excluded compound renders the instant claims obvious, when, for example, in the instant case, R^2 is 3-phenoxyphenyl.

Claims 47, 51-54, 58 and 60-62 are again rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The basis

of this rejection is the same as given in the previous office action and is incorporated herein fully by reference.

Applicants point to the introductory portion of the application. However, self study of a compound is not a utility and Applicants need to state which diseases and/or symptoms are to be treated.

Patent protection is granted in return for an enabling disclosure of an invention, not for vague intimations of general ideas that may or may not be workable. Tossing out the mere germ of an idea does not constitute enabling disclosure. *Genentech Inc. v. Novo Nordisk* 42 USPQ2d 1001.

As the Supreme Court said in *Brenner v. Manson*, 148 USPQ at 696: “a patent is not a hunting license. It is not a reward for the search, but compensation for its successful conclusion.” As U.S. Court of Customs and Patent Appeals stated *In re Diedrich* 138 USPQ at 130, quoting with approval from the decision of the board: “We do not believe that it was the intention of the statutes to require the Patent Office, the courts, or the public to play the sort of guessing game that might be involved if an applicant could satisfy the requirements of the statutes by indicating the usefulness of a claimed compound in terms of possible use so general as to be meaningless and then, after his research or that of his competitors has definitely ascertained an actual use for the compound, adducing evidence intended to show that a particular specific use would have been obvious to men skilled in the particular art to which this use relates.”

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bruck Kifle whose telephone number is 571-272-0668. The examiner can normally be reached on Mondays-Fridays from 8:30 AM -6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached on 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Bruck Kifle/
Primary Examiner
Art Unit 1624

BK
January 14, 2009